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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,434	02/18/2000	Ravi Acharya	47004.000059	8248

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HUNTON & WILLIAMS  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON, DC 20006-1109

EXAMINER

BERGIN, JAMES S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/506,434

Applicant(s)

ACHARYA ET AL. 

Examiner

James S. Bergin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/31/2002 and 4/29/2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-13, 15-19, 21-24, 27, 28 and 30-49 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 6-9, 12, 16, 18, 19, 22-24, 27, 28 and 30-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 10, 11, 13, 15, 17 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of species of claims 1, 4, 10, 11, 15, 17 and 21 (species 1C, 2E and 3B) in the paper received by fax on 4/29/2002 is acknowledged.

2. Newly submitted claims 30-49 are directed to another species of the invention that is independent or distinct from the species elected without traverse in the paper received on 4/29/2002 for the following reasons: This newly claimed species of the invention additionally claims that the system and method are further configured to provide provisional credit to the bank customer.

Since applicant has received an action on the merits for the originally presented species of the invention, this new species of the invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-49 are withdrawn from consideration as being directed to a non-elected species of the invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Information Disclosure Statement***

3. Please note that copies of references U20-U140, P1 and P2, which were listed on FORM PTO-1449 filed 1/23/2001 (paper 8), and listed again on FORM PTO-1449 filed 8/8/2001 (paper 12) have still not been received by the examiner and have therefore not been considered at this time. References U1-U19 were received and

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have been previously considered by the examiner as indicated on the FORM PTO-1449 attached to the first action mailed on 7/31/2001.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,10,11,13,15 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Riach et al. (5,751,842).

Riach et al. disclose a check depositing system and method comprising a remote processing terminal 10, connected to data processing circuitry suitable for electronic funds transfer whereby the customer's bank account can be automatically credited with the monetary value of a conventional check (column 2, lines 18-28). The customer logs on to the automated banking system using a bankcard and pin number and is authorized to continue. The customer enters information from the check into the customer terminal using the keyboard 14 (column 4, lines 30-34). A funds transfer operation is effected wherein the value of the check is transferred from the payer's account to the payee's account (column 4, lines 39-47 and claim 1), this process including the check clearing process.

Regarding claims 10 and 11, Riach et al. disclose digital image lift device 38 (column 12, lines 7-34).

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Regarding claim 13, Riach et al. disclose a printer for issuing receipts 300 from the slot 17. Riach et al. system also endorses the check by printing 252 (column 4, lines 35-39) so as to prevent redeposit.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riach et al. (5,751,842).

Riach et al. disclose a check depositing system and method as described above. However, the Riach et al. disclosure does not specifically mention having a personal computer as a customer terminal (claim 4) and the step of a provisional credit being applied to a bank customer's account (claim 17). The examiner takes official notice that having a personal computer as a customer terminal and the step of a provisional credit being applied to a bank customer's account, are both old and well-known expedients in the art, which are notoriously well known by those of ordinary skill in the art at the time that the invention was made. Therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made, to provide a personal computer as a customer terminal and/ or include the step of providing a provisional credit to a bank customer's account in the Riach et al. check depositing system and method,

because in doing so, one of ordinary skill would simply be availing of both old and well known expedients in the art.

### ***Response to Arguments***

8. Applicant's arguments filed 12/31/2002 have been fully considered but they are not persuasive. The addition of the new limitation, "the customer terminal further being selectively locatable by a customer payee (bank customer)" added to independent claims 1, 15 and 21 fails to overcome the rejection under 35 U.S.C. 102(b) of claims 1,10,11,13,15 and 21 and the rejection under 35 U.S.C. 103(a) of claims 4 and 17 outlined above.

This new limitation, "the customer terminal further being selectively locatable by a customer payee" can be broadly interpreted to mean that the customer payee or bank customer can choose to locate the customer terminal or can choose not to locate the customer terminal. If the claim writer's intent was to limit the customer terminal to some sort of portable terminal as distinct from a stationary or fixed terminal such as an ATM machine, this has not been accomplished by the language "selectively locatable".

Similarly, using a broad interpretation of the applicant's claim language, Riach et al. (5,751,842) disclose an automated banking system and a check clearing system configured to effectuate deposit of the discrete value of a check into an account of a customer payee. The Riach et al. apparatus comprises an automated banking system or system for banking. The checks deposited in the Riach et al. apparatus are processed or cleared by the Riach et al. apparatus itself. Therefore, the Riach et al. apparatus also comprises a check clearing system. The applicants claims also calls for

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a communication link connecting the automated banking system to the customer terminal interface, and a communication link connecting the check clearing system to the automated banking system and an interface to the check clearing system. Riach et al. meets these limitations because in using a broad interpretation it can be appreciated that the apparatus of the Riach et al. automated banking system contains communication links between all of its component parts, such as between the check clearing component, the customer terminal interface etc. Thus applicant might want to further define the nature of the communication links in the claim language to overcome the rejections outlined above.

Regarding the examiner's taking of official notice with regard to claims 4 and 17, the examiner reasserts that having a personal computer as a customer terminal and the step of a provisional credit being applied to a bank customer's account are both old and well known expedients in the art and thus would have been obvious to one of ordinary skill in the art at the time that the invention was made. **To successfully traverse this official notice the applicant must state why the noticed facts are not considered to be common knowledge or well-known in the art.**

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-1396 for regular communications and 703 308-1396 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.



James S. Bergin

September 4, 2002



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600